

Remarks/Arguments

1. Title Requirements

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The title of the invention has been amended. Accordingly, Applicants respectfully request that Examiner's objection as to the title be removed.

2. Abstract Requirements

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

The originally filed abstract, filed on August 15, 2001, commences on a separate sheet in accordance with 37 CFR 1.52(b)(4). Examiner's attention is drawn to page 69 of the originally filed specification, where the abstract appears alone. Accordingly, Applicants respectfully request that Examiner's objection as to the abstract be removed.

Although the preliminary amendment filed November 15, 2001, shows amendments to the abstract on pages 53 and 109, wherein the amendments to the abstract are not presented on a separate sheet, 37 CFR 1.52(b)(4) is directed towards the presentation of originally filed applications as opposed to 37 CFR 1.115 and 1.121, which are directed towards the presentation of preliminary amendments.

3. 35 U.S.C. § 112 Rejections

Claims 1 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements.

In light of the forgoing amendments to claims 1 and 30, Applicants respectfully request that this rejection be removed. Specifically, the language "determining a current financial portfolio for the user using the Internet" and "code segments for determining a current financial portfolio for the user using the Internet" is no longer recited by claims 1 and 30.

Claims 1, 16 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In light of the forgoing amendments to claims 1, 16, and 30, Applicants respectfully request that this rejection be removed. Specifically, the term "various products" is no longer recited by claims 1, 16, and 30, and the claims are in accordance with MPEP § 2172.01.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In providing guidance for interpreting 35 U.S.C. § 112, second paragraph, MPEP § 2173.05(a) states:

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings...If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more.

In light of the forgoing, Applicants respectfully assert that the terms "user investment style" and "user bull/bear market attitude" satisfy the requirement 35 U.S.C. § 112, second paragraph. Specifically, one skilled in the art would understand that these phrases describe a quantification of the user's investment decisions. Moreover, the specification and drawings make the meaning of these terms clear, as required by MPEP § 2173.05(a) (see, specification pp. 32-37; Figures 8 and 9, describing processes whereby "user investment style" and "user bull/bear market attitude" may be ascertained).

Accordingly, Applicants assert that the meanings of the terms "user investment style" and "user bull/bear market attitude" are "apparent...from the specification and drawings" in accordance with MPEP § 2173.05(a) and 35 U.S.C. § 112, second paragraph. Applicants respectfully request that this rejection be removed.

Claim 3 recites the limitation "the user's responses". There is insufficient antecedent basis for this limitation in the claim.

In light of the forgoing amendments to claim 3, Applicants respectfully request that this rejection be removed. Specifically, the first occurrence of the term "the user's response" has been changed to read "a response to each negative scenario received from the user."

Claim 6 recites the limitation "the securities list" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

In light of the forgoing amendments to claims 1 and 6, Applicants respectfully request that this rejection be removed. Specifically, the term "the securities list" has been changed to read "the recommended securities" and is first introduced in claim 1.

4. 35 U.S.C. § 102 Rejections

Claims 1-42 are rejected under 35 U.S.C. 102(e) as being anticipated by *Jones et al.*, U.S. Patent No. 6,021,397.

Claims 1-42 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Jones et al. (U.S. Patent No. 6,021,397). Because each and every element of every claim is not taught by the reference as required by MPEP § 2131, the Examiner's § 102 rejections are unsupported by the art and should be withdrawn.

The present claimed invention generally provides for developing a web-based financial portfolio remotely over the Internet through an automated financial portfolio coaching and risk management system, including:

- identifying a current financial portfolio of a user;
- identifying a user profile based on personal financial parameters of the user including at least a risk tolerance level; and
- providing to the user over an Internet customized financial coaching tailored to the life intentions of the user, wherein the customized financial coaching includes suggestions for changes to the current financial portfolio reflecting the user profile, wherein the suggestions are presented in a natural language format, and wherein the suggestions include financial products and recommended securities for the user to purchase.

Because not every element of every claim is taught by the *Jones* reference, Applicants respectfully request that Examiner's § 102 rejections be withdrawn. *Jones* fails to teach at least providing "suggestions for changes to the current financial portfolio...presented in a natural language format...wherein the suggestions include financial products and recommended securities for the user to purchase" as claimed.

The *Jones* reference discloses a financial advisory system that provides return scenarios to a user for optimizing portfolio allocations. See, col. 2, lines 48-64. Specifically, with respect to securities, the *Jones* reference merely offers suggestions including, "rebalance the portfolio" and "adjust investment risk." See col. 6, lines 17-26. However, far from recommending actual securities for the user to purchase—or even for swapping, as recited in claims 6, 7, 12, 13, 21, 22, 26, 27, 35, 36, 39, and 40—the *Jones* reference models scenarios where the variables include investment "core assets," or "factor asset

classes," such as cash, bonds, equities, and foreign equities. Col. 8, line 50-Col. 9, line 25. The equities of *Jones* are further broken down into more classifications, including large cap stock (growth or value), mid cap stock (growth or value), and small cap stock (growth or value). *Id.*

However, none these high-level classifications recommend actual securities for purchasing or swapping as claimed in the present invention. Such level of comprehensive customization, which is provided for by the present claimed invention, is not taught by *Jones*. Moreover, *Jones* also fails to disclose providing suggestions or recommendations in a "natural language format" as claimed in the present invention.

For at least these reasons, not every element of every claim is taught by the *Jones* reference, Applicants respectfully request that Examiner's § 102 rejections be withdrawn.

5. Conclusion

For at least the reasons presented above, Applicants assert that the application is now in condition for allowance. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7386. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-375602).

Respectfully submitted,



Christopher R. Hilberg, Reg. No. 48,740
Customer No. 29838

OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55405
Phone: (612) 607-7386
Fax: (612) 607-7100
E-mail: CHilberg@Oppenheimer.com